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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,134	05/30/2007	Mark D. Erion	2358.0080002/RWE/RAS	9214
26111 7590 04/15/2010 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER SHIAO, REI TSANG				
ART UNIT		PAPER NUMBER		
1628				
MAIL DATE		DELIVERY MODE		
04/15/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/580,134

Applicant(s)

ERION ET AL.

Examiner

REI-TSANG SHIAO

Art Unit

1628

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 83, 100, 232 and 241-255 is/are pending in the application.
- 4a) Of the above claim(s) 83 and 100 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 232 and 241-255 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Amendment of claims 232, and 241, cancellation of claims 1-82, 84-99, 101-231, and 233-240 in the amendment filed on January 28, 2010 is acknowledged. Claims 83, 100, 232 and 241-255 are pending in the application.

Responses to Amendments/Arguments

2. Since the variable R4 of formula (VIII) still represents aryl, therefore the rejection of claims 232 and 241-255 under 35 U.S.C. 102(a) or 102(e) over Ryono et al. '288 is maintained.

3. The phrase "Claims 92, 130 and 163-204" in line 3 on page 6 of the previous Office action dated 7/28/2009 shall be read "Claims 232 and 241-255". Since the variable R1 or R2 of formula (VIII) does not represent hydrogen, the rejection of claims 232 and 241-255 under 35 U.S.C. 102(b) over (1) Ibrahimi et al. '000; (2) Hopper et al. '269; (3) Li et al. '687; or (4) Gibbs et al. '163 has been overcome in the amendment filed on January 28, 2010.

4. It is noted that the variable R1 or R2 of formula (VIII) still independently represents alkyl. It is well-established that consideration of a reference (i.e., Li et al. '687) is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art, see *in re Boe*, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 279,

280 (CCPA 1976). Therefore Li et al. '687 compounds still render obviousness over the instant invention. The rejection of claims 232 and 241-255 under 35 U.S.C. 103(a) over Li et al. '687 is maintained.

5. Since the variable R1 or R2 of formula (VIII) does not represent hydrogen, the rejection of claims 232 and 241-255 under 35 U.S.C. 103(a) over Gibbs et al. '163 has been overcome in the amendment filed on January 28, 2010.

6. Since a terminal disclaimer against US 7,514,419 has not been filed to the Office, the rejection of claims 232 and 241-255 under the obviousness-type double patenting is maintained. Since a terminal disclaimer against co-pending application No. 11/816,774 has not been filed to the Office, the provisional rejection of claims 232 and 241-255 under the obviousness-type double patenting is maintained. Applicants are requested to file terminal disclaimers to overcome the rejection.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rei-tsang Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/REI-TSANG SHIAO /
Primary Examiner, Art Unit 1628

April 05, 2010